

REMARKS

Claims 1-42 and 44-53 are pending in the present patent application. Claims 1-16 are allowed. Claims 17-42 and 44-53 stand rejected. This application continues to include claims 1-42 and 44-53.

Applicant thanks the Examiner for allowing claims 1-16.

Claims 17-24, 26, 28, 30, 48, and 50-53 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kato, U.S. Patent No. 6,141,111 (hereinafter, Kato) in view of Iguchi, et al., U.S. Patent No. 6,473,153 B2 (hereinafter, Iguchi). Applicant respectfully requests reconsideration of the rejection of claims 17-24, 26, 28, 30, 48, and 50-53 in view of the following.

Kato is directed to printing, including providing various designations relative to an extra-copy printing using, for instance, an extra-copy designation sheet (col. 1, lines 8-10). An extra-copy designation sheet 100, includes a user ID input portion 101, a bin output selection portion 104, an E-mail deliver selection portion 105, an image index portion 102 and an extra-copy check portion 103 (col. 5, lines 25-29). In order to produce the extra-copy designation sheet 100, image data taken by a digital still camera is stored in image data memory 65 of image printer 26, and when the operator designates printing of the designation sheet 100, CPU 1 of image printer 26 compresses the image data, which is used for image index portion 102 (col. 5, lines 48-61), and the extra-copy designation sheet 100 is printed based on the number of copies of the image (col. 5, line 62 to col. 6, lines 5).

Kato discloses a process wherein an image is taken by digital still camera 11 at step S1, which is transferred to the image printer at step S2 (col. 6, lines 6-16, Fig. 5). The image printer then produces the extra-copy designation sheet 100 at step S3, and the operator then enters

information onto the extra-copy designation sheet 100 at step S4, and inputs extra-copy designation sheet 100 into image printer 26 at step S5 (col. 6, lines 17-25, Fig. 5).

At step S6, image printer 26 recognizes the data entered by the operator, and stores the recognition results in extra-copy designation sheet recognition result data portion 58 at step S7 (col. 6, lines 26-33, Fig. 5). The images are then emailed or sorted by user ID and printed at steps S8-S10 (col. 6, lines 34-52, Fig. 5).

Iguchi is directed to a photographic print producing method (col. 1, lines 7-8).

Photosensitive material exposed by a print producing unit 205 is developed and dried to produce a photographic print P1 (development-print simultaneous process), photographic print P2 (enlarged print) and photographic print P3 (guide print) (col. 13, lines 1-5). The guide print displays sample images with different degrees of lightness and color tone using the sample image, an example of which is shown in Fig. 3 (col. 13, lines 28-32). The guide print P3 is then given to the customer, who designates an image suited to his preference by encircling “OK” below the image, and the marked print P3 is read by the reflective original input apparatus 210 (col. 14, lines 1-8).

Guide print P3 includes a print portion and a transparent sheet TS, which is marked by the customer, and only the sheet TS is input into the reflective original input apparatus 210 to allow reading of the character even if written on a black image with a black pen (col. 18, lines 32-50, Fig. 9).

Iguchi also discloses that trimming region designation information of the guide print P2 can be formed by the customer himself directly entering it on the frame image 10 using a ball-point pen, felt tipped pen, pencil or any desired writing tool W (col. 22, lines 47-50, Fig. 13).

In addition, trimming a human face formed on photographic print P1 may be performed using guide print P2, wherein trimming region designation information is formed on the frame image by the customer (col. 25, lines 39-46).

The use of guide print P2 for designating trimming region and instruction information for photographic print P1 is described from column 27, line 16, to column 28, line 31, in which Iguchi discloses that a transparent material P2a is laid on top of the guide print P2 so that trimming region designation, instruction information, and other types of information can be directly written onto the transparent material (col. 27, lines 30-34). Since the rewritable transparent material P2a is used, the information is not directly entered on the guide print P2 per se or in the photographic print P1 per se, which prevents the guide print P2 or photographic print P1 from being contaminated (col. 27, lines 39-43, Fig. 20).

In addition, an auxiliary tool S can be used, wherein the trimming region designation and other information is not directly written on photographic print P1 and guide print P2 per se, preventing photographic print P1 and guide print P2 from being contaminated (col. 28, lines 21-31, Fig. 21).

Applicant believes that claims 17-24, 26, 28, 30, 48, and 50-53 patentably define Applicant's invention over Kato and Iguchi, taken alone or in combination, for at least the reasons set forth below.

Claim 17 is directed to a method for selecting images from a plurality of images obtained from a digital device for printing with an imaging apparatus, said imaging apparatus having a scanner and accessing a memory storing said plurality of images.

Claim 17 recites, in part, generating a selection sheet from said thumbnail printout by placing a first designation mark directly on each thumbnail of said plurality of thumbnails

corresponding to each image of said plurality of images on which a first action is to be taken; and detecting said first designation mark by scanning said selection sheet with said scanner.

The Examiner acknowledges that Kato does not teach placing a mark directly on the thumbnail, but asserts that Iguchi does so.

In contrast to generating a selection sheet from the thumbnail printout by placing a first designation mark directly on each thumbnail of the plurality of thumbnails corresponding to each image of the plurality of images on which a first action is to be taken, as recited in claim 17, Iguchi discloses that the guide print P3 is given to the customer, who designates an image suited to his preference by encircling "OK" below the image, and the marked print P3 is read by the reflective original input apparatus 210 (col. 14, lines 1-8).

Thus, the customer markings disclosed by Iguchi are not placed directly on each thumbnail.

In addition, Iguchi discloses that the guide print P3 includes a print portion and a transparent sheet TS, which is marked by the customer, and only the sheet TS is input into the reflective original input apparatus 210 to allow reading of the character even if written on a black image with a black pen (col. 18, lines 32-50, Fig. 9). Accordingly, Iguchi does not disclose, teach, or suggest detecting the first designation mark by scanning the selection sheet with the scanner, since the Iguchi transparent sheet TS is not a selection sheet within the context of claim 17. That is, transparent sheet TS is not a selection sheet generated from a thumbnail printout by placing a first designation mark directly on a thumbnail, as recited in claim 17, since the Iguchi marks are placed directly on a transparent sheet TS, not the print portion of guide print P3.

The Examiner asserts that Iguchi discloses placing a mark directly on the thumbnail at column 22, lines 47-67 and Fig. 15, and asserts that Iguchi discloses messages written directly on

the images as well as selecting faces by marking directly on the thumbnails (paragraph bridging pages 2 and 3 of the present Office Action).

With respect to this assertion, Iguchi discloses that that trimming region designation information of the guide print P2 can be formed by the customer himself directly entering it on the frame image 10 using a ball-point pen, felt tipped pen, pencil or any desired writing tool W (col. 22, lines 47-50, Figs. 13 and 15), and that trimming a human face formed on a photographic print P1 may be performed using guide print P2, wherein trimming region designation information is formed on the frame image by the customer (col. 25, lines 39-46).

However, Iguchi discloses that a transparent material P2a is laid on top of the guide print P2 so that trimming region designation, instruction information, and other types of information is directly written onto the transparent material (col. 27, lines 30-34). Since the rewritable transparent material P2a is used, the information is “not directly entered” on the guide print P2 per se or in the photographic print P1 per se, which prevents the guide print P2 or photographic print P1 from being contaminated (col. 27, lines 39-43, Fig. 20, emphasis added).

In addition, an auxiliary tool S can be used, wherein the trimming region designation and other information is “not directly written on photographic print P1 and guide print P2” per se, preventing photographic print P1 and guide print P2 from being contaminated (col. 28, lines 21-31, Fig. 21, emphasis added).

Thus, in contrast to placing a first designation mark directly on each thumbnail of the plurality of thumbnails corresponding to each image of the plurality of images on which a first action is to be taken, Iguchi specifically and explicitly teaches that marks are not directly entered or written onto any corresponding Iguchi thumbnail, but rather, are written on a transparent sheet, which prevents contamination of the Iguchi guide print and photographic print.

Accordingly, for at least the reasons set forth above, Applicant respectfully submits that Kato and Iguchi, taken alone or in combination, do not disclose, teach, or suggest the subject matter of claim 17.

Claims 18-24, 26, 28, and 30 are believed allowable due to their dependence, directly or indirectly, on otherwise allowable base claim 17. In addition, claims 18-24, 26, 28, and 30 further and patentably define Applicant's invention over Kato and Iguchi, taken alone or in combination.

For example, claim 24 is directed to the method of claim 17, wherein the step of performing said first action includes inhibiting printing.

Kato does not disclose, teach, or suggest the subject matter recited in claim 24 for at least the reasons set forth in Applicant's previous response, electronically filed September 22, 2006.

Although the Examiner asserts that the Iguchi images that are not designated by the first mark for printing are not printed out, which assertedly discloses inhibiting printing, Applicant respectfully submits that, as recited in claim 17, performing the first action is based on detecting the first designation mark. Thus, with Applicant's invention, the rather than not printing an image that is not designated, the printing of designated images is inhibited, which is the opposite of what the Examiner asserts.

That is, rather than not printing based on not detecting a designation mark, Applicant's claimed invention performs the action of inhibiting printing, as recited in claim 24, based on detecting the first designation mark, as recited in claim 17, from which claim 24 depends.

In support thereof, Applicant respectfully directs the Examiner to Applicant's specification at page 14, lines 8-10, which is reproduced below for the sake of convenience.

In a case where the user wishes to print all of plurality of images 56 except for a certain image or certain images, step S212 includes printing all images except for those images designation for the action of inhibiting printing. (Emphasis added).

Accordingly, Kato and Iguchi, taken alone or in combination, do not disclose, teach, or suggest wherein the step of performing the first action includes inhibiting printing, as recited in claim 24.

Claim 24 is thus believed allowable in its own right.

Claim 26 is directed to the method of claim 17, and recites, in part, wherein the step of generating said selection sheet further includes placing a second designation mark directly on each thumbnail of said plurality of thumbnails corresponding to each image of said plurality of images on which a second action is to be taken, said second designation mark being different from said first designation mark, and said second action being different from said first action; and the step of detecting includes detecting both said first designation mark and said second designation mark by scanning said selection sheet with said scanner.

Claim 26 is believed allowable in its own right for substantially the same reasons as set forth above with respect to claim 17.

Claim 30 is directed to the method of claim 17, wherein said scanner is an alignment sensor used for aligning a printhead of said imaging apparatus.

Kato does not disclose, teach, or suggest the subject matter recited in claim 17 for at least the reasons set forth in Applicant's previous response, electronically filed September 22, 2006.

In addition, the entire Kato disclosure does not even mention the word, "sensor," much less alignment sensor, and does not otherwise disclose, teach, or suggest wherein a scanner is an alignment sensor used for aligning a printhead of the imaging apparatus.

Further, Kato does not otherwise disclose, teach, or suggest that scanner 3 is an alignment sensor used for aligning a printhead of the imaging apparatus.

In addition, Iguchi does not disclose, teach, or suggest wherein the scanner is an alignment sensor used for aligning a printhead of the imaging apparatus. Rather, Iguchi discloses that the guide print is read by a reflective original input apparatus 210 (col. 14, lines 6-8), but does not in any manner disclose, teach, or suggest that reflective original input apparatus 210 is an alignment sensor used for aligning a printhead of an imaging apparatus.

Further, the entire Iguchi disclosure does not even mention the words, “sensor,” “alignment,” or “align,” much less an alignment sensor used for aligning a printhead.

The Examiner asserts that “[t]he scanner must have some way of aligning in order for the image data to be read and acted upon and every scanner is a sensor.”

Without regard to whether a scanner must have some way of aligning, and whether a scanner is a sensor, Applicant respectfully submits that the Examiner’s assertion is not based on any statement or declaration in the Iguchi disclosure.

In addition, aligning a scanner in order for image data to be read and acted upon is unrelated aligning a printhead.

Kato and Iguchi, taken alone or in combination, do not disclose how a printhead alignment is performed, if any.

In the Response to Arguments, the Examiner asserts that “Every scanner is comprised of sensors and those sensors must be used to perform alignment in Kato.” Without regard to whether every scanner is comprised of sensors, there is simply no support in the Kato disclosure for the proposition that the Kato scanner 3 is an alignment sensor used for aligning a printhead of an imaging apparatus.

Applicant respectfully submits that the Examiner’s assertion is not based on any statement or declaration in the Kato disclosure, and is not otherwise supported by the Kato disclosure. Kato

simply does not disclose, teach, or suggest that scanner 3 is used for aligning a printhead of an imaging apparatus, and Iguchi simply does not disclose, teach, or suggest that reflective original input apparatus 210 is used for aligning a printhead of an imaging apparatus.

MPEP 2143 provides that the basic requirements to establish a *prima facie* case of obviousness include that the prior art reference (or references when combined) must teach or suggest all the claim limitations. (Emphasis added).

However, neither Kato nor Iguchi, taken alone or in combination, disclose, teach, or suggest the limitations of claim 30, that is, wherein the scanner is an alignment sensor used for aligning a printhead of the imaging apparatus.

Accordingly, Kato and Iguchi, taken alone or in combination, do not disclose, teach, or suggest the subject matter recited in claim 30.

Claim 30 is thus believed allowable in its own right.

Claim 48 is directed to a method for selecting images from a plurality of images obtained from a digital device for printing with an imaging apparatus, said imaging apparatus having a scanner and accessing a memory storing said plurality of images.

Claim 48 recites, in part, generating a selection sheet from said thumbnail printout by placing a first designation mark directly on each thumbnail of said plurality of thumbnails corresponding to each image of said plurality of images on which a first action is to be taken; and placing a second designation mark directly on each thumbnail of said plurality of thumbnails corresponding to each image of said plurality of images on which a second action is to be taken, said second designation mark being different from said first designation mark, and said second action being different from said first action; and detecting said first designation mark and said second designation mark by scanning said selection sheet with said scanner.

Kato and Iguchi, taken alone or in combination, do not disclose, teach, or suggest the subject matter recited in claim 48 for substantially the same reasons as set forth above with respect to claim 17.

Claims 50-53 are believed allowable due to their dependence, directly or indirectly, on otherwise allowable base claim 48. In addition, claims 50-53 further and patentably define Applicant's invention over Kato and Iguchi, taken alone or in combination.

For example, claim 53 is directed to the method of claim 48, wherein said scanner is an alignment sensor used for aligning a printhead of said imaging apparatus.

Claim 53 is believed allowable in its own right for substantially the same reasons as set forth above with respect to claim 30.

Accordingly, for at least the reasons set forth above, Applicant believes that claims 17-24, 26, 28, 30, 48, and 50-53 are in condition for allowance in their present form, and thus respectfully request that the rejection of claims 17-24, 26, 28, 30, 48, and 50-53 under 35 U.S.C. 103(a) be withdrawn.

Claims 25, 27, 29, and 49 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Kato, Iguchi, and Lumley, U.S. Patent No. 7,009,726 B2 (hereinafter, Lumley). Applicant respectfully requests reconsideration of the rejection of claims 25, 27, 29, and 49 in view of the following.

Claims 25, 27, 29, and 49 are believed allowable due to their dependence on their otherwise allowable respective base claims 17, and 48, since, as set forth above with respect to claims 17 and 48, Kato and Iguchi, taken alone or in combination, do not disclose, teach, or suggest the subject matter of claims 17 and 48, and since Lumley does not make up for the deficiency of Kato and Iguchi as applied to claims 17 and 48, nor does the Examiner assert as

much. Rather, the Examiner relies on Lumley for the subject matter recited in claims 25, 27, 29, and 49.

Accordingly, for at least the reasons set forth above, Applicant believes that claims 25, 27, 29, and 49 are in condition for allowance in their present form, and thus respectfully requests that the rejection of claims 25, 27, 29, and 49 under 35 U.S.C. 103(a) be withdrawn.

Claims 31-41, 44, and 46 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Kato and Yoshihara, et al., U.S. Patent No. 6,031,632 (hereinafter, Yoshihara). Applicant respectfully requests reconsideration of the rejection of claims 31-41, 44, and 46 in view of the following.

Yoshihara is directed to an image retrieval apparatus capable of printing a mark sheet for retrieval (col. 1, lines 11-12). Yoshihara discloses a reader unit 1 for converting an original into image data, coupled to a printer unit 2 for outputting the image data onto a recording sheet (col. 2, lines 46-52, Fig. 1). Reader unit 1 includes an original-feeding device 101 that conveys originals onto an original-mount glass 102, which is scanned by a CCD 109 based scanner unit 104 (col. 2, line 66 to col. 3, line 6, Figs. 2 and 3).

Yoshihara discloses a mark sheet having marks 1105 and 1106 that identify the sheet as a mark sheet, and are also used for correcting misregistration of the mark sheet; a mark 1107 that is used for discriminating between the up and down positions of the mark sheet, and for correcting misregistration of the mark sheet; and a mark 1108 is used for correcting misregistration of the mark sheet (col. 10, lines 28-33, Fig. 7). The mark sheet is read by reader unit 1 (col. 11, line 28). If the mark 1107 for discriminating between the up and down positions of the mark sheet is present immediately below the mark 1105, it is determined that the up and down positions of the mark sheet are correct, whereas if the mark 1107 is absent, i.e., if the mark sheet is identified by

the mark 1106, it is determined that the up and down positions of the mark sheet are reversed (col. 12, lines 32-38).

Applicant believes that claims 31-41, 44, and 46 patentably define Applicant's invention over Kato and Yoshihara, taken alone or in combination, for at least the reasons set forth below.

Claim 31 is directed to a method for selecting images from a plurality of images obtained from a digital device for printing with an imaging apparatus, said imaging apparatus having a scanner and accessing a memory storing said plurality of images.

Claim 31 recites, in part, detecting said at least one orientation symbol by scanning said selection sheet with said scanner, wherein said scanner is an alignment sensor used for aligning a printhead of said imaging apparatus.

Kato does not disclose, teach, or suggest wherein the scanner is an alignment sensor used for aligning a printhead of the imaging apparatus for substantially the same reasons as set forth above with respect to claim 30.

In contrast to detecting an orientation symbol by scanning the selection sheet with a scanner, wherein the scanner is an alignment sensor used for aligning a printhead of the imaging apparatus, as recited in claim 31, Yoshihara discloses a reader unit 1 including an original-feeding device 101 that conveys originals onto an original-mount glass 102, which is scanned by a CCD 109 based scanner unit 104 (col. 2, line 66 to col. 3, line 6, Figs. 2 and 3). The mark sheet is read by reader unit 1 (col. 11, line 28).

Thus, Yoshihara discloses that the mark sheet is read by a conventional flat bed CCD-based scanner 104 (see Fig. 2), which does not disclose, teach, or suggest an alignment sensor used for aligning a printhead of the imaging apparatus.

Yoshihara simply does not in any manner otherwise disclose, teach, or suggest that conventional flat bed CCD-based scanner 104 is used as an alignment sensor used for aligning a printhead of the imaging apparatus.

MPEP 2143 provides that the basic requirements to establish a *prima facie* case of obviousness include that the prior art reference (or references when combined) must teach or suggest all the claim limitations. (Emphasis added).

However, neither Kato nor Yoshihara, taken alone or in combination, disclose, teach, or suggest the limitations of claim 31, wherein the scanner is an alignment sensor used for aligning a printhead of an imaging apparatus.

Accordingly, for at least the reasons set forth above, Applicant respectfully submits that Kato and Yoshihara, taken alone or in combination, do not disclose, teach, or suggest the subject matter of claim 31. Claim 31 is thus believed allowable in its present form.

Claims 32-41, 44, and 46 are believed allowable due to their dependence, directly or indirectly, on otherwise allowable base claim 31. In addition, claims 32-41, 44, and 46 further and patentably define Applicant's invention over Kato and Yoshihara, taken alone or in combination.

For example, claim 34 is directed to the method of claim 33, wherein said at least one orientation symbol is configured to indicate at least four possible orientations of said thumbnail printout.

The Examiner acknowledges that Kato does not disclose, teach, or suggest orientation symbols.

In contrast to claim 34, wherein the at least one orientation symbol is configured to indicate at least four possible orientations of the thumbnail printout, as recited in claim 34,

Yoshihara discloses that a mark 1107 that is used for discriminating between the up and down positions of the mark sheet (col. 10, lines 30-31).

Discriminating between the up and down positions, as disclosed by Yoshihara, addresses only two possible orientations of the Yoshihara mark sheet, which clearly does not disclose, teach, or suggest wherein the at least one orientation symbol is configured to indicate at least four possible orientations of the thumbnail printout, as recited in claim 34

MPEP 2143 provides that the basic requirements to establish a prima facie case of obviousness include that the prior art reference (or references when combined) must teach or suggest all the claim limitations. (Emphasis added).

However, neither Kato nor Yoshihara, taken alone or in combination, disclose, teach, or suggest the limitations of claim 34, that is, wherein the at least one orientation symbol is configured to indicate at least four possible orientations of the thumbnail printout.

Accordingly Kato and Yoshihara, taken alone or in combination, do not disclose, teach, or suggest the subject matter recited in claim 34, since Kato and Yoshihara, taken alone or in combination, do not disclose, teach, or suggest all of the claim limitations recited in claim 34.

Claim 34 is thus believed allowable in its own right.

Claim 37 is directed to the method of claim 36, wherein said orientation is determined based on detecting a number of elongate bars.

The Examiner acknowledges that Kato does not disclose, teach, or suggest orientation symbols.

In contrast to wherein the orientation is determined based on detecting a number of elongate bars, Yoshihara discloses that if the mark 1107 for discriminating between the up and

down positions of the mark sheet is present immediately below the mark 1105, it is determined that the up and down positions of the mark sheet are correct, whereas if the mark 1107 is absent, i.e., if the mark sheet is identified by the mark 1106, it is determined that the up and down positions of the mark sheet are reversed (col. 12, lines 32-38).

Thus, Yoshihara discloses determining orientation of the mark sheet based on the relative position of mark 1107 and mark 1105, that is, based on whether the mark 1107 is below mark 1105.

An orientation determination based on a relative position of marks does not disclose, teach, or suggest wherein the orientation is determined based on detecting a number of elongate bars, since whether the mark 1107 is above or below the mark 1105, there are still the same number of Yoshihara marks, but the orientation is determined differently in each case (mark 1105 being above mark 1105 vs. mark 1107 being below mark 1105).

Claim 37 is thus believed allowable in its own right.

Accordingly, for at least the reasons set forth above, Applicant believes that claims 31-41, 44, and 46 are in condition for allowance in their present form, and thus respectfully requests that the rejection of claims 31-41, 44, and 46 under 35 U.S.C. 103(a) be withdrawn.

Claims 42, 45, and 47 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Kato and Yoshihara, as applied to claim 31, and in further view of Lumley. Applicant respectfully requests reconsideration of the rejection of claims 42, 45, and 47 in view of the following.

Claims 42, 45, and 47 are believed allowable due to their dependence on their otherwise allowable base claim 31, since, as set forth above with respect to 31, Kato and Yoshihara, taken alone or in combination, do not disclose, teach, or suggest the subject matter of claim 31, and

since Lumley does not make up for the deficiency of Kato and Yoshihara as applied to claim 31, nor does the Examiner assert as much. Rather, the Examiner relies on Lumley for the subject matter recited in claims 42, 45, and 47.

Accordingly, for at least the reasons set forth above, Applicant believes that claims 42, 45, and 47 are in condition for allowance in their present form, and thus respectfully request that the rejection of claims 42, 45, and 47 under 35 U.S.C. 103(a) be withdrawn.

For the foregoing reasons, Applicant submits that no combination of the cited references teaches, discloses or suggests the subject matter of the appended claims. The appended claims are therefore in condition for allowance, and Applicant respectfully requests withdrawal of all rejections and allowance of the claims.

In the event Applicant has overlooked the need for an extension of time, an additional extension of time, payment of fee, or additional payment of fee, Applicant hereby conditionally petitions therefor and authorizes that any charges be made to Deposit Account No. 20-0095,

TAYLOR & AUST, P.C.

Should any question concerning any of the foregoing arise, the Examiner is invited to telephone the undersigned at (317) 894-0801.

Respectfully submitted,

/Paul C. Gosnell/

Paul C. Gosnell
Registration No. 46,735

Attorney for Applicant

RKA14/ts

TAYLOR & AUST, P.C.
12029 E. Washington Street
Indianapolis, IN 46229
Telephone: 317-894-0801
Facsimile: 317-894-0803

Electronically Filed: February 23, 2007